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EXAMINER

MENBERU, BENIYAM

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2625

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/006,530	Applicant(s) AKIMOTO ET AL.	
	Examiner BENIYAM MENBERU	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-9,16,20 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-9,16,20 and 23-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/30/2009, 12/11/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments with respect to claims 1 and 16 have been considered but are moot in view of the new ground(s) of rejection.
2. Applicant stated in the Remarks pages 12-13, that the system of Iwazaki '742 does not disclose "plurality of image files, each of which includes image data for one of the pages of the original". However Examiner disagrees because as shown in Figure 8, there is image file structure having an tag data ("IFD") for each image page of data. The combination of the "IFD" and image data for each page forms the **image file** for a page. Thus as shown in Figure 8, there are plurality of such image files (column 11, lines 19-45, 54-57; column 13, lines 35-45; the TIFF format defines the structure shown in Figure 8;).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16 and 26-28 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying

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subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "Clarification of 'Processes' under 35 U.S.C. 101" – publicly available at USPTO.GOV, "memorandum to examining corp"). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. In order for a process to be "tied" to another statutory category, the structure of another statutory category should be positively recited in a step or steps significant to the basic inventive concept, and NOT just in association with statements of intended use or purpose, insignificant pre or post solution activity, or implicitly.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 2, 7, 8, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6157706 to Rachelson in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al further in view of

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U.S. Patent No. 6097797 to Oseto further in view of U.S. Patent No. 6687742 to Iwazaki further in view of U.S. Patent No. 6956663 to Iida.

Regarding claim 1, Rachelson '706 disclose a communication apparatus comprising:

registration means for registering a plurality of electronic mail accounts of a plurality of clients via a first network upon receiving a plurality of requests from the clients (column 8, lines 3-15; The address book is the registration means. The requests occur when e-mails are received from someone the first time. Figure 9a shows plurality of e-mail accounts; column 8, lines 15-27;), wherein each of the requests includes a customized format of an image to be received (column 10, lines 21-31; see "recipient preferences" ; column 11, lines 21-29; Figure 2, the administrator 100 communicates over Internet);
reception means for receiving facsimile data, from a second network that uses a different communication protocol from the first network (column 10, lines 65-67; column 11, lines 1-10; Figure 1, the fax 110 is connected to telephone system 103 and the EPO is connected to an Internet; EPO receives fax data from 103 as shown in Figure 2;);
confirming means for confirming whether each of the clients maintains a valid account (column 11, lines 12-18; column 8, lines 21-27);
generating means for generating a plurality of electronic mails directed to the electronic mail accounts of the clients, (column 8, lines 15-27; plurality of electronic mails is generated since there can be email transmission for each entry in the address book shown in Figure 9a (column 10, lines 21-25); column 11, lines 21-29; outgoing e-mail;) wherein each of the electronic mails has an attachment generated based on the

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received facsimile data (column 11, lines 21-29; "received fax message") received by said reception means (The FAX server 200 is the reception means for facsimile reception from FAX 110. In Figure 2, for "OUTGOING MAIL" procedure, "TIF Image of the FAX" as shown in Figure 2 as output of FAX server 200 goes to Mail Processor 202, where it clearly shows as an output of 202 "EMAIL message with TIF as MIME or UU **Attachment**". Further this goes as output of SMTP server as "OUTGOING Email Message" to destination 120. Thus the attachment for the EMAIL is based on the TIF image of Fax as shown. Figure 12 shows the OUTGOING Mail process. Although in Figure 12, the attachment is not discussed it is clear from Figure 2, that there is attachment of the facsimile image data. Further in column 10, lines 40-59, in the INMAIL process which is opposite of OUTGOING Mail process discussed above, attachments are processed for incoming emails which are converted to facsimile data.), and also based on the customized format for each of the clients registered by said registration means (Further with respect to the "customized format of an image for the client received by said registration means", Figure 12, shows step 1216 which does conversion to "preferred format" (customized format) of the recipient (column 11, lines 21-29), wherein preferred formats GIF, UU, Encode, MIME, Postscript and TIF (as default). The "recipient database" reads on the registration means, since the "recipient database" has information about the preferred format of the recipient. see also column 10, lines 23-31;); and transmission means for transmitting the electronic mails generated by said generating means to the electronic mail account of the client (column 11, lines 30-38).

However Rachelson '706 does not disclose transmitting the electronic mail to the electronic mail accounts of clients.

Oseto '797 discloses transmitting the electronic mail to the electronic mail accounts of clients (column 4, lines 23-27; column 5, lines 18-65; clients CL are the destinations with email addresses; fax data received from sender facsimile 121/122 is transmitted as email to plurality of clients CL ; email address are registered in a table (column 7, lines 45-67)).

Having the system of **Rachelson '706** and then given the well-established teaching of **Oseto '797**, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of **Rachelson '706** as taught by **Oseto '797**, since **Oseto '797** stated in col. 5, Lines 26-42, such a modification would provides facsimile relay system using address number for email transmission.

However Rachelson '706 does not disclose wherein data includes color image information and/or monochrome image information.

Blair et al discloses receiving color image information (page 5, paragraph 48, page 6-7, paragraph 64; color image is received at destination "PHOTOWORKS").

Having the system of **Rachelson '706** and then given the well-established teaching of **Blair et al '524**, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of **Rachelson '706** as taught by **Blair et al '524**, since **Blair et al '524** stated in pages 3-4, paragraph 30, such a modification would provide color image transmission to different selectable destinations as needed.

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Rachelson '706 disclose customized format for received facsimile data (column 10, lines 65-67; column 11, lines 1-10; Figure 1, the fax 110 is connected to telephone system 103 and the EPO is connected to an Internet; EPO receives fax data from 103 as shown in Figure 2; Figure 12, shows step 1216 which does conversion to "preferred format" (customized format) of the recipient (column 11, lines 21-29), wherein preferred formats GIF, UU, Encode, MIME, Postscript and TIF (as default). However Rachelson '706 does not disclose wherein the generating means generates the plurality of electronic mails based on the customized format including, in a first case, information regarding dividing the image data into several pages to create one file from each page.

Iwazaki '742 discloses wherein the generating means generates the plurality of electronic mails based on the customized format including, in a first case, information regarding dividing the image data into several pages to create one file from each page, for attaching to a single electronic mail for at least one of the clients (Figure 7, 8; Figure 8 shows the division of image data into plurality of pages for email attachment; column 11, lines 19-45, 54-57; column 13, lines 35-45; the **TIFF format** defines the structure shown in Figure 8; The IFD (image file directory) is the image file created for each page; the file shown in Figure 8 is attached to a single e-mail message for transmission).

Having the system of ***Rachelson '706*** and then given the well-established teaching of ***Iwazaki '742***, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of ***Rachelson '706*** as taught by ***Iwazaki '742***, since ***Iwazaki '742*** stated in column 1, lines 26-42, column 11, lines

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28-35, such a modification would provide the formatting necessary for transmitting pages of image data by email using facsimile device.

However Rachelson '706 does not disclose wherein the generating means generates the plurality of electronic mails based on the customized format including, in a second case, information regarding grouping all pages of the image data into a single file, for attaching to a single electronic mail for at least one of the clients.

lida '663 discloses wherein the generating means generates the plurality of electronic mails based on the customized format including, in a second case, information regarding grouping all pages of the image data into a single file, for attaching to a single electronic mail for at least one of the clients (column 4, lines 23-34; attachment; column 6, lines 11-15; received data; column 7, lines 12-19; column 9, lines 52-67; column 11, lines 19-50; "single communication" reads on single email; column 12, lines 28-36; in step 1402 the plurality of document files (plurality of pages; each file can represent a page) are merged into single file).

Having the system of **Rachelson '706** and then given the well-established teaching of **lida '663**, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of **Rachelson '706** as taught by **lida '663**, since **lida '663** stated in col. 2, Lines 5-20; column 11, lines 19-50; such a modification would provide an efficient method for email data transferring

Regarding claim 2, Rachelson '706 in view of Blair et al '524 further in view of Oseto '797 further in view of Iwazaki '742 further in view of Iida '663 teach all the limitations of claim 1. Further Rachelson discloses the communication apparatus according to claim 1, wherein said generating means attaches an image received by said reception means to the electronic mail (column 11, lines 21-29; column 10, lines 40-49).

Regarding claim 7, Rachelson '706 in view of Blair et al '524 further in view of Oseto '797 further in view of Iwazaki '742 further in view of Iida '663 teach all the limitations of claim 1. Further Rachelson discloses the communication apparatus according to claim 1, wherein at least one of the customized formats includes information on an encoding system of said attached image (column 11, lines 25-29).

Regarding claim 8, Rachelson '706 in view of Blair et al '524 further in view of Oseto '797 further in view of Iwazaki '742 further in view of Iida '663 teach all the limitations of claim 1. Further Blair et al discloses the communication apparatus according to claim 1, wherein said reception means receives the color and/or monochrome image information based on a facsimile procedure (page 5, paragraph 48, page 6-7, paragraph 64; page 4, paragraph 30, lines 5-7).

Regarding claim 16, see Rejection of claim 1 as shown above. The apparatus of Rachelson '706 in view of Blair et al '524 further in view of Oseto '797 further in view of Iwazaki '742 render obvious the method disclosed in claim 16.

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2. Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6157706 to Rachelson in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al further in view of U.S. Patent No. 6097797 to Oseto further in view of U.S. Patent No. 6687742 to Iwazaki further in view of U.S. Patent No. 6956663 to Iida further in view of U.S. Patent No. 6658456 to Shimoosawa.

Regarding claim 5, Rachelson '706 in view of Blair et al '524 further in view of Oseto '797 further in view of Iwazaki '742 further in view of Iida '663 teach all the limitations of claim 1. However Rachelson '706 in view of Blair et al '524 further in view of Oseto '797 further in view of Iwazaki '742 does not disclose the communication apparatus according to claim 1, wherein at least one of the customized formats includes information on whether to attach the image to the electronic mail.

Shimoosawa '456 discloses the communication apparatus according to claim 1, wherein at least one of the customized formats includes information on whether to attach the image to the electronic mail (column 5, lines 13-20; column 9, lines 57-67; column 10, lines 16).

Having the system of ***Rachelson '706 in view of Blair et al '524 further in view of Oseto '797 further in view of Iwazaki '742 further in view of Iida '663*** and then given the well-established teaching of ***Shimoosawa '456***, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of ***Rachelson '706 in view of Blair et al '524 further in view of Oseto '797 further in view of Iwazaki '742 further in view of Iida '663***, since ***Shimoosawa '456***

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stated in Figure 4, and column 5, lines 13-29, such a modification would provide destination based processing of received data.

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6157706 to Rachelson in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al further in view of U.S. Patent No. 6097797 to Oseto further in view of U.S. Patent No. 6687742 to Iwazaki further in view of U.S. Patent No. 6956663 to Iida further in view of U.S. Patent No. 6721783 to Blossman et al.

Regarding claim 6, Rachelson '706 in view of Blair et al '524 further in view of Oseto '797 further in view of Iwazaki '742 further in view of Iida '663 teach all the limitations of claim 1. However Rachelson '706 in view of Blair et al '524 further in view of Oseto '797 further in view of Iwazaki '742 further in view of Iida '663 does not disclose the communication apparatus according to claim 1, wherein at least one of the customized formats includes information on whether to attach all or a part of said received image.

Blossman et al disclose the communication apparatus according to claim 1, wherein at least one of the customized formats includes information on whether to attach all or a part of said received image (Blossman et al disclose method of sending bank customers images of bank related documents through email based on customer preference on which documents to be sent (column 16, lines 1-5, lines 23-33, lines 45-54).).

Having the system of ***Rachelson '706 in view of Blair et al '524 further in view of Oseto '797 further in view of Iwazaki '742 further in view of Iida '663*** and then given the well-established teaching of ***Blossman et al '783***, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of ***Rachelson '706 in view of Blair et al '524 further in view of Oseto '797 further in view of Iwazaki '742 further in view of Iida '663*** as taught by ***Blossman et al '783***, since ***Blossman et al '783*** stated in column 4, lines 38-41, such a modification would provide a destination specific transmission of important documents based on preference of users.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6157706 to Rachelson in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al further in view of U.S. Patent No. 6097797 to Oseto further in view of U.S. Patent No. 6687742 to Iwazaki further in view of U.S. Patent No. 6956663 to Iida further in view of U.S. Patent No. 6883016 to Fujii et al.

Regarding claim 9, Rachelson '706 in view of Blair et al '524 further in view of Oseto '797 further in view of Iwazaki '742 further in view of Iida '663 teaches all the limitations of claim 8. However Rachelson '706 in view of Blair et al '524 further in view of Oseto '797 further in view of Iwazaki '742 further in view of Iida '663 does not disclose the communication apparatus according to claim 8, wherein said facsimile procedure is based on the ITU-T T. 37 recommendation.

Fujii et al '016 disclose facsimile procedure based on the ITU-T T. 37 recommendation (column 1, lines 15-24).

Having the system of ***Rachelson '706 in view of Blair et al '524 further in view of Oseto '797 further in view of Iwazaki '742 further in view of Iida '663*** and then given the well-established teaching of ***Fujii et al '016***, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of ***Rachelson '706 in view of Blair et al '524 further in view of Oseto '797 further in view of Iwazaki '742 further in view of Iida '663*** as taught by ***Fujii et al '016***, since ***Fujii et al '016*** stated in column 1, lines 20-23, such a modification would provide image transmission through email using ITU-T T.37 standard which is required.

5. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6157706 to Rachelson in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al further in view of U.S. Patent No. 6097797 to Oseto further in view of U.S. Patent No. 6687742 to Iwazaki further in view of U.S. Patent No. 6956663 to Iida further in view of U.S. Patent No. 6356356 to Miller, Jr et al.

Regarding claim 20, Rachelson '706 in view of Blair et al '524 further in view of Oseto '797 further in view of Iwazaki '742 further in view of Iida '663 teaches all the limitations of claim 1. Rachelson '706 does disclose transmission of electronic mail based on information registered at said registration means (column 8, lines 4-14, 21-29; the address book is the registration means which registers information (email address)). However Rachelson '706 in view of Blair et al '524 further in view of Oseto

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'797 further in view of Iwazaki '742 further in view of Iida '663 does not disclose the communication apparatus according to claim 1, wherein said transmission means transmits the electronic mail generated by said generating means to a plurality of clients based on information.

Miller, Jr et al '356 discloses transmitting the electronic mail generated by said generating means to a plurality of clients based on information (column 5, lines 54-67; column 6, lines 1-8; "more than one destination" reads on plurality of clients; the information stored in step 46 is the information used for transmission to plurality of clients.).

Having the system of ***Rachelson '706 in view of Blair et al '524 further in view of Oseto '797 further in view of Iwazaki '742 further in view of Iida '663*** and then given the well-established teaching of ***Miller, Jr et al '356***, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of ***Rachelson '706 in view of Blair et al '524 further in view of Oseto '797 further in view of Iwazaki '742 further in view of Iida '663*** as taught by ***Miller, Jr et al '356***, since ***Miller, Jr et al '356*** stated in col. 4, lines 43-55, such a modification would provide "broadcasting" capabilities for facsimile to email transmission.

6. Claims 23, 24, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6658456 to Shimoosawa in view of U.S. Patent No. 6363412 to Niwa et al.

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Regarding claim 23, Shimoosawa '456 discloses an image communication apparatus that performs facsimile communications through the Internet (column 4, lines 41-55), the apparatus comprising:

a registration unit configured to register an E-mail address to be received (Figure 4 shows registration of sender ID 51 which can include e-mail address to be received ; column 4, lines 65-67; column 5, lines 1-29;), an E-mail address of a transfer destination (column 5, lines 1-29; transfer address 52), and transfer content including an indication that transfer of an attached file is necessary (column 5, lines 12-29; "transfer attribute" 53 determines the transfer content; column 9, lines 18-41; Figure 4, reference 53 determines whether appended file is deleted or transferred; column 8, lines 48-63; user can only receive the main part (body) of email without appended file (attached file) or user can receive the attachment when necessary (column 9, lines 25-35));

a reception unit configured to receive the E-mail body and the attached file using an Internet facsimile procedure (column 8, lines 48-61; main part (body) and appended part (attachment) in email; Figure 3, reference 31; column 4, lines 45-56; column 7, lines 9-19; "Internet 101" used for communication for facsimile device 1); and

a transfer unit configured to select the E-mail body or the attached file received by the reception unit and transfer the selected E-mail body or the selected attached file to the E-mail address of the transfer destination registered by the registration unit, according to the transfer content registered by the registration unit (Figure 3, reference 44 transfers email; column 6, lines 33-38; column 9, lines 25-35; column 8, lines 48-63;

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user has option to receive just main part (body) of email without attachment). However Shimoosawa '456 does not disclose transfer content including an indication that transfer of an E-mail body is unnecessary.

Niwa et al '412 discloses transfer content including an indication that transfer of an E-mail body is unnecessary (column 1, lines 35-41; column 5, lines 46-55; Figure 13 shows source (receiving address), destination (transfer) address which is stored in server (transferring device) and also size of mail body which are parts of the mail header; column 8, lines 65-67; column 9, lines 1-10; column 2, lines 44-67; column 3, lines 1-15; the size of mail body is an indication for whether the mail body will be transferred to terminal B (transfer destination) since it is used in determination of whether the mail body is necessary).

Having the system of **Shimoosawa '456** and then given the well-established teaching of **Niwa et al '412**, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of **Shimoosawa '456** as taught by **Niwa et al '412**, since **Niwa et al '412** stated in col. 3, lines 60-67; col. 4, lines 20-24, such a modification would provide efficiency in usage of memory.

Regarding claim 24, Shimoosawa '456 in view of Niwa et al '412 teaches all the limitations of claim 23. Further Shimoosawa '456 discloses the image communication apparatus according to Claim 23, wherein the transfer content indicates one of: transmission of only the E-mail body, transmission of only the attached file, and

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transmission of the E-mail body and the attached file is selectable (column 5, lines 12-29; "transfer attribute" 53 determines the transfer content; column 9, lines 18-41; Figure 4, reference 53 determines whether appended file is deleted or transferred; column 8, lines 48-63; user can only receive the main part (body) of email without appended file (attached file) or user can receive the attachment when necessary (column 9, lines 25-35)).

Regarding claim 26, see rejection of claim 23 as shown above. The apparatus of Shimoosawa '456 in view of Niwa et al '412 renders obvious the method of claim 26.

Regarding claim 27, see rejection of claim 24 as shown above. The apparatus of Shimoosawa '456 in view of Niwa et al '412 renders obvious the method of claim 27.

7. Claims 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6157706 to Rachelson in view of U.S. Patent No. 6275850 to Beyda et al.

Regarding claim 25, Rachelson '706 discloses a communication terminal apparatus that performs facsimile transmission and reception through a public network and is connected to a plurality of clients through a local area network (LAN) (Figure 2, terminals 200, 202, 204 form the communication terminal; fax transmission/reception using line 103 (public network) ; LAN connection using system 204; column 5, lines 60-67; column 6, lines 22-27; column 7, lines 19-22), the apparatus comprising:

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a reception unit configured to receive images by facsimile communications through the public network (column 10, lines 65-67; column 11, lines 1-10; Figure 1, the fax 110 is connected to telephone system 103 (public network) and the EPO is connected to an Internet; EPO receives fax data from 103 as shown in Figure 2;););

a registration unit configured to register registration information that includes information indicating how to convert the images received by the reception unit (column 10, lines 21-31; "recipient preference" in database includes type of conversion that recipients require for fax data), in correspondence with electronic mail addresses of clients of transmission destinations (column 11, lines 12-19; "recipient database" contains destination address information;), and indicating whether to attach files when transmitting electronic mails (Figure 2, reference 200 generates TIF image from fax data and reference 202 generates attachment for email based on TIF data; column 10, lines 44-46; column 11, lines 21-38);

a judgment unit configured to judge whether a client of a transmission destination has been registered by the registration unit (column 11, lines 5-20 step 1210 checks if destination address has been registered);

an electronic mail creation unit configured to, if the client of the transmission destination is judged to be registered by the registration unit, create an electronic mail based on the registration information, and, if the registration information corresponding to the client indicates that a file is to be attached to the electronic mail, convert an image received by

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the reception unit into the file, and attach the file to the electronic mail (column 10, lines 44-46; column 11, lines 14-29; conversion step 1216); and

a transmission unit configured to transmit the electronic mail, to which the file has been attached, to the client of the transmission destination (column 11, lines 34-37).

However Rachelson '706 does not disclose a registration unit configured to register registration information indicating whether the files include all or a part of the images received by the reception unit.

Beyda et al '850 discloses disclose a registration unit configured to register registration information indicating whether the files include all or a part of the images received by the reception unit (column 3, lines 54-67; server 12 stores message that are received; column 5, lines 7-14, 24-37; column 6, lines 63-67; column 7, lines 1-60; the attaching filter 42 determines the information whether all or some of received files by the server 12 is transmitted to client 14; if filter 42 is turned off then all files received will be sent to client 14 otherwise some of the files will be sent to client 14 based on the filtering result).

Having the system of **Rachelson '706** and then given the well-established teaching of **Beyda et al '850**, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of **Rachelson '706** as taught by **Beyda et al '850**, since **Beyda et al '850** stated in col. 2, Lines 21-41, such a modification would provide user with a selectable attachment of email files.

Regarding claim 28, see rejection of claim 25 as shown above. The apparatus of Rachelson '706 in view of Beyda et al '850 renders obvious the method of claim 28.

Other Prior Art Cited

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6618749 to Saito et al disclose facsimile device.

U.S. Patent No. 7095517 to Hori disclose facsimile system.

U.S. Patent No. 6020980 to Freeman disclose email processing system.

U.S. Patent No. 6104500 to Alam et al disclose facsimile relay system.

U.S. Patent No. 6493105 to Onuma disclose facsimile system.

U.S. Patent No. 6078921 to Kelley disclose file processing system.

U.S. Patent Application Publication No. US2001/0007992 A1 to Nakaoka disclose email processing system.

U.S. Patent Application Publication No. US2002/0071136 A1 to Bobrow et al disclose message processing.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENIYAM MENBERU whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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